

## REMARKS

The §112(2) rejections are addressed as follows:

- **“the upper surface” (claims 1, 22, 29, and 36):** These rejections are not understood. The Office Action states that “[a] tile may have more than one upper surface”, but the preambles of all of these claims recite that the tiles have upper surfaces, and the bodies of the claims follow this language such the meanings of the claims are evident. We submit that these claims comport with 35 USC §112(2), since an ordinary artisan would comprehend the bounds of the claims when read in light of the specification. As noted by the Court of Appeals for the Federal Circuit in *Miles Laboratories Inc. v. Shandon Inc.*, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993):

The "distinctly claiming" requirement [of 35 USC §112(2)] means that the claims must have a clear and definite meaning when construed in the light of the complete patent document. ... Section 112 thus ensures definiteness of claim language. ... The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. ... If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more.

(Citations omitted.) Here, it is believed that the “upper surface” language is clear and definite, both when read in a vacuum and even more so when read in light of the specification. Please note MPEP 2173 *et seq.*, particularly MPEP 2173.02 (“Clarity and Precision”). If these rejections are maintained, clarification of the rejection is needed; in particular, suggested alternative claim language would be helpful. In this event, it may be possible to resolve all issues via telephone, and perhaps via an Examiner’s Amendment.

- **“these tile... boundaries” (claim 1):** Claim 1 has been amended to obviate this rejection.
- **“the plane... surface” (claims 6 and 36):** It is felt that these rejections should be withdrawn owing to the precepts noted in MPEP 2173.05(e) (“Lack of Antecedent Basis”):

[T]he failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) (“controlled stream of fluid” provided reasonable antecedent basis for “the controlled fluid”). Inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation “the outer surface of said

sphere" would not require an antecedent recitation that the sphere has an outer surface. See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of "an ellipse" provided antecedent basis for "an ellipse having a major diameter" because "[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter").

It is submitted that the claims are in accordance with 35 USC §112(2) since their meanings are readily ascertainable by an ordinarily skilled artisan within a reasonable degree of certainty (MPEP 2173.02), particularly insofar as "the plane of the upper bed surface" is an inherent feature of the bed surface, just as an "outer surface" is an inherent component of a sphere (the example given in MPEP 2173.05(e)).

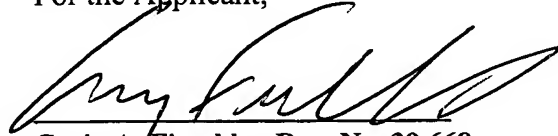
- **"the standard stock tiles" (claims 20, 27 and 34):** "standard stock tiles" is recited in the preamble of claims 1, 22, and 29, from which each respective rejected claim depends. Again, it is not seen how the recited language is in any way indefinite or unclear/confusing: each claim means exactly what it says when read in light of its parent claim (and in view of the specification). One of ordinary skill can readily determine what infringes and what does not, which is all that §112(2) requires (as per the *Miles Laboratories* case discussed above).
- **"the tile boundaries therein" (claim 22):** Claim 22 has been amended to obviate these rejections.
- **"the upper surface" (claim 24):** See the foregoing comments regarding "the upper surface" in claims 1, 22, 29, and 36.
- **"its tile boundary" (claims 29 and 36):** Claims 29 and 36 have been amended to obviate these rejections.
- **"trenches" (claim 36):** This language was included in error, and claim 36 is amended to fix this issue.

In summary, all claims are believed to be clear and definite, particularly when read in light of the specification. The requirements of §112(2) are therefore met, and the rejections should be withdrawn.

The indication that claims 1-40 contain allowable matter is noted and appreciated.

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,

A handwritten signature in black ink, appearing to read 'Craig A. Fieschko', written over a horizontal line.

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